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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,909	11/05/2003	Robert Allen Ahti	132446	2908
31838	7590	08/23/2005	EXAMINER	
HASSE GUTTAG & NESBITT LLC 7550 CENTRAL PARK BLVD. MASON, OH 45040			SHAKERI, HADI	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

THH

Office Action Summary	Application No. 10/605,909	Applicant(s) AHTI ET AL.	
	Examiner Hadi Shakeri	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 10-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 10-13 is/are rejected.
- 7) ☒ Claim(s) 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>042005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The substitute Abstract submitted on 06/09/05 is objected to. Deleted words should be removed from the Abstract and should not be placed within brackets.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 5 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 5, the language, i.e., "a laser bore...forming an outlet opening in a front portion of the nozzle proximate the coolant outlet" as recited in lines 4 and 5 of section 3, renders the claim indefinite. While specification as originally filed describes a bore (22) forming an opening (24) through an outer surface (26), it does not describe "an outlet" in a front portion of the nozzle proximate the coolant outlet (29), and since the interface (30) forming the other opening of the bore cannot be defined as an "outlet opening" in a front portion and/or proximal to the nozzle outlet (29).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1, 2, 4-6 and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Regarding claims 1, 5 and 6, the language as written renders the claims indefinite. The article claims, i.e., a machining apparatus including a coolant nozzle and/or a coolant nozzle as recited, renders the scope of the claims ascertainable, since a "nozzle" as defined by the art and by the specification as originally filed, cannot be defined to include the laser (it would be inoperable), and without the plug it would lack sufficient structure to make it operable. The recitation that the laser is removably inserted does not remedy the deficiencies. Does the nozzle include the plug or the laser? It cannot include both, since specification as originally filed does not provide sufficient support for a nozzle including both the laser device (40) and the plug (50).

7. Claim 4 is indefinite for depending on the cancel claim 3. Further the language, e.g., prior to forming renders the claim indefinite. It appears surface (56) is being claimed, e.g., ...wherein the surface mimics an inner surface of the flow passage.

8. Claims 10 and 11 fail to further limit the parent claims. It appears Applicant is claiming the shape or profile of the workpiece, since machining interface depends on the shape of workpiece and/or the tool.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

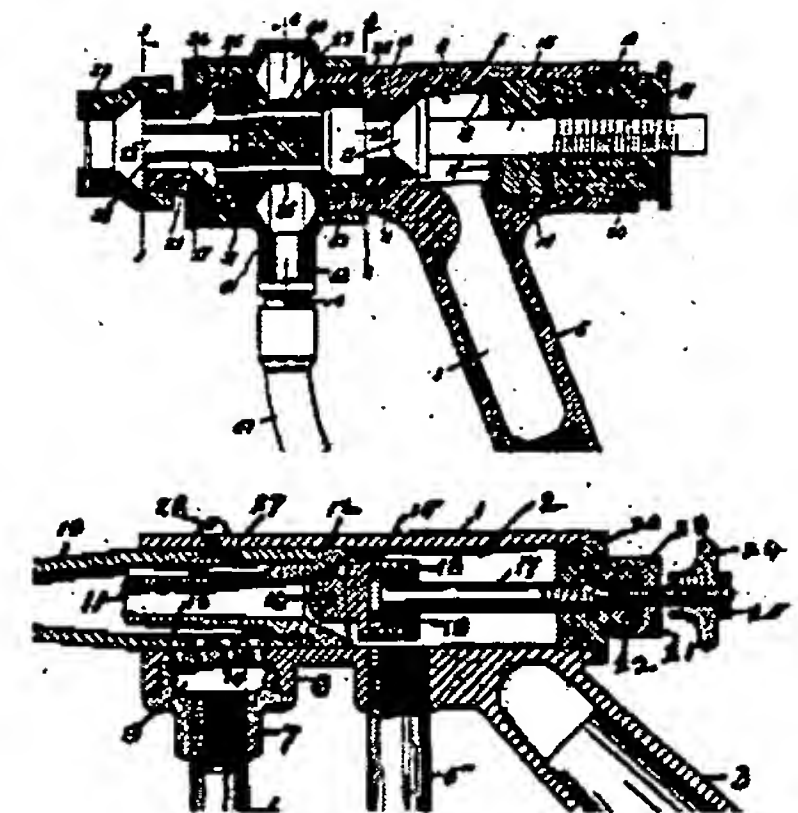
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 6, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by either one of Pletcher (2,071,472), or Phillips (675,840).

Either one of Pletcher or Phillips discloses all of the limitations of the above claims as best understood, i.e., a nozzle with a removal plug.



Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5 and 11 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo (6,386,948) in view of anyone of Goldsmith et al. (5,759, 031) or Fusaro, Jr. (6,374,158).

Kondo meets all of the limitations of the above claims, as best understood, i.e., metal machining apparatus comprising a coolant nozzle (52), except for disclosing the use of a laser for aligning the nozzle.

The use of a laser to point or target a nozzle is old as evident by prior art cited above. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Kondo with a laser pointing device as taught by anyone of prior art cited above to target the cooling fluid. With regards to location of parts (e.g. within the nozzle or mounted on the outside) and/or removable laser, it is noted it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikes*, 86 USPQ 70; and that

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constructing a formerly integral structure in various elements involves only routine skill in the art.

Nerwin v. Erlichman, 168 USPQ 177, 179.

13. Claims 1, 2, 4 and 10 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. (6,902,469) in view of anyone of Pletcher or Phillips.

Kondo meets all of the limitations of the above claims, as best understood, i.e., metal machining apparatus comprising a coolant nozzle, which may be used with additives and the additives for the coolant may include a surfactant or synthetic type lubricant, a rust inhibitor, a non-ferrous metal anticorrosive, an antiseptic and an antifoaming agent, except for disclosing a removable plug.

Pletcher or Phillips teaches nozzles wherein the amount of a supply source is controlled. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Kondo with a nozzle control as taught by anyone of prior art cited above to adjust the amount of additives based on the workpiece/operational parameters.

Allowable Subject Matter

14. Claims 14-16 are allowed.

15. The following is a statement of reasons for the indication of allowable subject matter: a method of grinding including a step of cooling the interface and a step of removing a plug and inserting a laser to emit the stream at the interface, prior to the machining operation places these claims allowable over prior art.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

17. Applicant's arguments with respect to claims 1, 24-6, and 10-13 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 571-272-4495. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Hadi Shakeri
Primary Examiner
Art Unit 3723
August 18, 2005